

Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed January 3, 2008.

I. Summary of Examiner's Rejections

Prior to the Office Action mailed January 3, 2008, Claims 1-59 were pending in the Application. In the Office Action, Claims 3-5, 11-13, 17-19, 25-27, 33-34, 41-42, 49-50, and 56-57 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 29-44 and 52-59 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kirsch (U.S. Patent No. 6,546,416, hereinafter Kirsch). Claims 1, 3-9, 11-15, 17-23, 25-28, and 45-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirsch.

II. Summary of Applicant's Amendment

The present Response amends Claims 1, 3-5, 7, 11-13, 15, 17-19, 21, 25-27, 45, 49 and 50; cancels Claims 29-44 and 52-59; and adds new Claims 60-67, leaving for the Examiner's present consideration Claims 1-28, 45-51 and 60-67. Reconsideration of the Application, as amended, is respectfully requested. Applicant respectfully reserves the right to prosecute any originally presented or canceled claims in a continuing or future application.

III. Claim Rejections under 35 U.S.C. § 112

In the Office Action mailed January 3, 2008, Claims 3-5, 11-13, 17-19, 25-27, 33-34, 41-42, 49-50, and 56-57 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

The present Response hereby amends Claims 3-5, 11-13, 17-19, 25-27 and 49-50 so as to more clearly define the embodiments therein. Applicant respectfully submits that as amended, these claims now comply with the requirements of 35 U.S.C. §112 and reconsideration thereof is respectfully requested. Claims 33-34, 41-42 and 56-57 have been canceled, rendering moot any rejections as to these claims.

IV. Claim Rejections under 35 U.S.C. § 103(a)

In the Office Action mailed January 3, 2008, Claims 1, 3-9, 11-15, 17-23, 25-28, and 45-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirsch (U.S. Patent No. 6,546,416, hereinafter Kirsch).

Claim 1

Claim 1 has been amended to more clearly define the embodiment therein. As amended, Claim 1 defines:

1. *A method for modifying mail filters associated with a user of a mail system, the method comprising:
receiving a subscription request by a sender, the subscription request including user information;
generating a petition by the sender based on the user information, the petition comprising a request for the sender to be added to a list of approved mail senders, the list associated with the user;
transmitting a token containing the petition from the sender to a recipient as a result of the subscription request and storing said token at the recipient;
receiving a login request from the user to the mail system;
checking for the token containing the petition in the recipient; and
processing said token containing the petition if the token is found in the recipient and modifying the mail filters associated with the user by adding the sender to the list of approved mail senders as specified in the petition.*

As amended, Claim 1 defines a method for modifying the mail filters of mail systems. The mail filters are modified by using a petition, which is created when a sender receives a subscription request (for example, at the time of subscription to an electronic newsletter). Once the subscription request is received, a petition is generated by the sender. The petition is then stored into a token and transmitted to the recipient as a result of the subscription request. The token (i.e. cookie or file) is stored on the recipient. After this, when the user attempts to log into the mail system, the recipient is checked for any tokens that contain a petition. If the token is found, the petition is processed and the mail filter is modified as specified in the petition at the time of the user logging into the mail system.

As such, Claim 1 features can make sure that the access list (e.g. white list) is updated automatically when the recipient subscribes to a newsletter from the sender, without sending any

emails back and forth and without requiring the user to manually answer questions or perform other undesirable actions.

One problem addressed by Claim 1 is that of a recipient signing up for a newsletter and then having to remember to add the recipient's email address to their "white list" or "access list" to make sure the email gets delivered. Often a recipient will sign up for a newsletter and then neglect to update their list (which is usually done via an email program that is not running at the time of signing up). This can cause the sender's email messages (newsletters) to get filtered with spam control. The features of Claim 1 can allow the access list to be automatically and reliably updated without transmitting any emails so as to prevent such inconveniences.

The Kirsch reference teaches a spam control technique by selectively blocking delivery of bulk electronic mail. More specifically, Kirsch uses a challenge/response method to verify emails. When an email is received from an unverified source, the system generates a challenge email along with a key and sends the challenge to the unverified address. The system then detects whether the response to the challenge email that is received from the source address contains the proper response key. As a result of this email exchange, the system may record the source address in a verified source address list (Kirsch, col. 3, lines 43-67). However, Applicant respectfully submits that Kirsch fails to disclose the features of Claim 1, as amended.

Firstly, Kirsch fails to disclose *storing a token containing a petition at the recipient as a result of the subscription request, receiving a login request to the mail system and then checking for the token containing the petition in the recipient*, as defined in amended Claim 1. No token nor any petition is stored in Kirsch. More importantly, there is no disclosure of checking for the token containing the petition in the recipient when the user attempts to log into the mail system, as defined in amended Claim 1. These features allow the recipient to receive and store a cookie during a typical HTTP session, which will later (at login time to the mail system) be used to update the access white list. Kirsch does not store any petition to update the access list. Instead, Kirsch sends challenge emails and receives email responses and if those emails are verified, then Kirsch updates the list of verified addresses. There is no disclosure of storing any tokens that contain the petition and then checking the recipient for the token that contains the petition when a user logs into the mail system, as defined in amended Claim 1.

Secondly, Kirsch fails to disclose *processing the token containing the petition if the token is found in the recipient and modifying the mail filters associated with the user by adding the*

sender to the list of approved mail senders as specified in the petition, as defined in amended Claim 1. Kirsch is not concerned with searching for any tokens on the recipient. Kirsch also fails to disclose processing the token containing the petition if it is found on the recipient. Furthermore, Kirsch does not describe modifying the mail filter as specified in the petition, as defined in amended Claim 1. These features of Claim 1 allow the user's access list to be automatically updated when the user logs into the mail system based on a token that was received and stored at some different time (e.g. during newsletter subscription). When the user logs in, the mail system checks the recipient for the token and if the token contains the petition, then the filters are automatically modified. No such functionality is described in Kirsch.

At a high level, Kirsch describes a challenge/response email mechanism, similar to those described in the background portion of the present disclosure (Specification, par. [0007]). These types of challenge/response solutions generally require a human user to authenticate themselves by responding to a “challenge” question which can practically be answered only by a human sender. However, this type of system can unwittingly filter out legitimate email that was not sent by a mail program that is not a human (such as an automatic newsletter, etc.). Kirsch describes such a system because it specifically aims to “discriminate against auto-responders.... in order to defeat auto-responders being statically programmed to make any single requested modification.” (Kirsch, col. 6, lines 29-41). In contrast, the embodiments defined in Claim 1 are aimed to allow legitimate automated systems to transmit emails by utilizing the petition and token mechanisms defined therein. As such, the features and purpose of the embodiments of Claim 1 are not disclosed in Kirsch.

In view of the above comments and amendments, Applicant respectfully submits that Claim 1, as amended, is neither anticipated by, nor obvious in view of the cited references, and reconsideration thereof is respectfully requested.

Claim 7

Claim 7 contains at least some of the limitations discussed above. Accordingly, the remarks made in connection with Claim 1 are incorporated herein by reference.

Additionally, Claim 7 defines that the token contains a reference to a location where the petition is located. When the user logs into the mail system, the recipient system is searched for a token and if the token is found, the petition is retrieved from a remote location (e.g. remote

server). This allows the petition provider to send a petition to a remote mail provider as part of a redirected URL and eliminates the need to install the petition processor on the recipient system. This functionality is also not anticipated, nor rendered obvious by the Kirsch reference.

Claims 15, 21 and 45

Claims 15, 21 and 45 while independently patentable, recite limitations that, similarly to those described above with respect to claims 1 and 7 are not taught, suggested nor otherwise rendered obvious by the cited references. Reconsideration thereof is respectfully requested.

Claims 2-6, 8-14, 16-20, 22-28 and 46-51

Claims 2-6, 8-14, 16-20, 22-28 and 46-51 are not addressed separately, but it is respectfully submitted that these claims are allowable as depending from an allowable independent claim, and further in view of the comments provided above. Applicant respectfully submits that Claims 2-6, 8-14, 16-20, 22-28 and 46-51 are similarly neither anticipated by, nor obvious in view of the cited references, and reconsideration thereof is respectfully requested.

It is also submitted that these claims also add their own limitations which render them patentable in their own right. Applicant respectfully reserves the right to argue these limitations should it become necessary in the future.

V. Claim Rejections under 35 U.S.C. § 102(e)

In the Office Action mailed January 3, 2008 Claims 29-44 and 52-59 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kirsch. The present Response hereby cancels Claims 29-44 and 52-59, rendering moot any rejections as to these claims. Reconsideration of the application as amended is respectfully requested.

VI. Additional Amendments

The present Response adds new dependent Claims 60-67. New Claims 60-67 are fully supported by the Specification as originally filed and no new matter is being added. Applicant respectfully submits that Claims 60-67 are allowable over the cited references of record and consideration thereof is respectfully requested.

VII. Conclusion

In view of the above amendments and remarks, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and reconsideration thereof is respectfully requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: April 3, 2008

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